

REMARKS

In the Advisory Action, pending claims 47 - 49 are rejected. Applicants have added new claims 50-59 by this Amendment. Support for the added claims can be found at pages 11-12 and 54-55. No new matter is added by this amendment. Accordingly, claims 47 - 59 are currently pending in this application.

A. Rejection under 35 U.S.C. §112, second paragraph

The rejection to claim 47 “as being indefinite because of the use of the term “a fragment” is maintained. The Advisory Action indicates that Applicants arguments were found to be “not persuasive because “a fragment” can be broadly interpreted as a single amino acid and a compound binds an immobilized amino acid would not inhibit HMGI biological activity.” The Advisory Action goes on to state, “[t]here is no evidence indicating a compound that binds any region of HMGI (any fragment of HMGI) would disrupt protein-DNA or protein-protein interaction, thus inhibit HMGI biological function.”

Applicants respectfully traverse the rejection of claim 47 under 35 U.S.C. §112, second paragraph. Claim 47 recites a method for screening candidate compounds capable of inhibiting HMGI biological activity. In a first aspect of the method, candidate compounds are identified using an HMGI protein or a fragment thereof in a binding assay. In other words, this aspect identifies compounds that may or may not inhibit HMGI biological function based on the compound’s ability to bind to HMGI or a fragment of HMGI. Since HMGI is the architectural component of the enhanceosome (transcription enhancer complex), it must interact with multiple proteins along with DNA. Thus, theoretically, any compound that binds to HMGI, regardless of what region it binds to, could disrupt this interaction. This first aspect of the invention screens for any of these compounds.

The results of this first aspect of the method are then used in a second aspect of the method. The second aspect of the method determines whether HMGI biological function is affected by the candidate compounds identified in the first aspect. In other words, the first aspect acts as an initial filter and the second aspect acts as a further filter that determines whether the candidate compounds identified by the first filter affect the biological function of HMGI. As a result, the use of fragments of HMGI, in the first aspect of the method, is appropriate and not indefinite. Specification of biologically active fragments of HMGI that would result in the identification of compounds that inhibit HMGI biological activity is not necessary to accomplish the claimed method since the first aspect of the method is one part of the screening method. Thus, the fragments of claim 47 may be any polypeptide with an amino acid sequence identical to any region of the HMGI protein. Accordingly, Applicants request withdrawal of this rejection.

B. Rejection under 35 U.S.C. §112, first paragraph

Claim 47 is rejected under 35 U.S.C. §112, first paragraph “because the specification does not identify the fragment of HMGI, unspecified fragments which do not contain functional domains such as DNA-binding domain and protein-binding domain would not accomplish the claimed method due to reasons stated above.”

Applicants respectfully traverse. For the reasons previously stated in response to the §112, second paragraph rejection, the fragments need not be limited to sequences that contain functional domains of HMGI. The aspect of the invention that involves the phrase “a fragment” is not the only step in the claimed method. The second aspect of the method determines which candidate compounds affect HMGI biological activity. As a result, fragments which do not contain functional domains of HMGI will nonetheless result in the accomplishment of the claimed method.

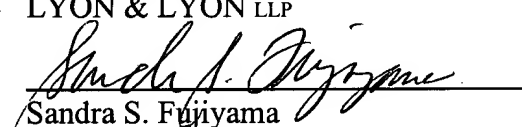
Accordingly, Applicants submit that it is not necessary to specify the fragments with the biological function or with the functional domains of HMGI for the claimed process.

CONCLUSION

Applicants believe that these amendments and responses are sufficient to overcome all of the rejections in the Advisory Action. Therefore, a prompt Notice of Allowance of claims 47 - 59 is respectfully requested. If Applicants can do anything more to assist in the entry of this amendment, Applicants request the Examiner to contact the undersigned at (213) 489-1600.

Dated: February 25, 2002

633 West Fifth Street, Suite 4700
Los Angeles, California 90071-2066
(213) 489-1600

Respectfully submitted,
LYON & LYON LLP
By: 
Sandra S. Fujiyama
Reg. No. 46,713